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09/083,122 05/22/98 MAJEED

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EXAMINER

OH, T

ART UNIT

PAPER NUMBER

1621

10

DATE MAILED:

09/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/083,122

Applicant(s)

Majeed et al

Examiner

TAYLOR VICTOR OH

Group Art Unit

1621



☒ Responsive to communication(s) filed on the amendment dated on July 6, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) 3 and 4 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, and 5-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Final Rejection

The Status of Claims

Claims 1-2 and 5-17 have been rejected.

Claims 3 and 4 have been canceled.

Claim Rejections-35 USC 103

2. Applicants' argument filed May 25, 1999 have been fully considered but they are not persuasive.

Rejection of claims 1-2 and 5-17 under 35 U.S.C. 103(a) as being unpatentable over Lewis (Methods in Enzymology, Vol. XIII, pp. 615-616, 1969) in view of Lowenstein (U.S. 3,764,692).

Claims 1-2 and 5-17 are rejected under 35 USC 103(a) as unpatentable over Lewis (methods in Enzymology, vol. XIII, pp. 615-616, 1969) in view of Lowenstein (U.S. 3,764,692) for the reasons of the record in paper no.8.

3. The applicants claim that the prior art Lewis differs from the claimed process in the followings:

a. the Lewis' process is directed to making hydroxycitric acid in lactone form,

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- b. Lewis treats an aqueous extract of Garcinia fruit with alcohol whereas the claimed process directly treats Garcinia fruit with alcohol,
- c. Lewis treats an aqueous extract of Garcinia fruit containing alcohol with KOH while the claimed process treats an alcohol extract with KOH, and
- d. the Lewis process undergoes numerous laborious steps after the KOH treatment step while the claimed process has only several simple steps after the KOH treatment step.

Furthermore, the applicants assert that the process resulted from the combination of the teachings of Lewis and Lowenstein would be even more laborious in comparison with the claimed process, which lead to the unobviousness.

The applicants' view have been well noted, but these arguments are not persuasive.

First of all, concerning the Lewis' process directed to making hydroxycitric acid in lactone form, even though the end product of the Lewis' process is hydroxycitric acid in lactone form, it is obvious for the person having an ordinary skill in the art to have used the first half of the process without going through a cation exchange resin and seeding with lactone crystals in order to obtain the desired product ; namely, potassium hydroxycitric acid.

Secondly, with respect to Lewis' treatment of the aqueous extract of Garcinia fruit with alcohol, the applicants argue that the claimed process directly treats Garcinia fruit with alcohol. It is natural for the Examiner to assume that Garcinia fruit may contain some water inside the fruit. Only a difference is that Lewis first cooks Garcinia fruit rind followed by the aqueous extraction with alcohol (see p. 615, lines 20-25) whereas the claimed Garcinia fruit is extracted with alcohol at a reflux temperature. Therefore, the claimed step is nothing more than the

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optimization of Lewis' process. Furthermore, the Examiner feels that no patentably distinct step is involved in that procedure.

Thirdly, regarding to Lewis' treatment of an aqueous extract of Garcinia fruit containing alcohol with KOH, the applicants dispute that the claimed process treats the alcohol extract with KOH. In the Lewis process, the supernatant of the mixture containing KOH is removed first; then the mixture is washed with 60% ethanol and subsequently with absolute alcohol (see p. 616, lines 2-4) whereas the claimed process treats the alcohol extract with KOH. It has been held that merely reversing the order of steps in a multi-step process is not a patentable modification absent unexpected or unobvious results. Ex parte Rubin, 128 U.S.P.Q. 440 (P.O.B.A. 1959). Cohn v. Comr. Patents, 251 F. Supp. 437, 148 U.S.P.Q. 486 (D.C. 1966).

Fourthly, concerning the combination of the teachings of Lewis and Lowenstein would be very laborious, not to mention Lewis process by itself in comparison with the claimed process having only several simple steps after the KOH treatment step. It is true that the end product of the Lewis process is directed to produce hydroxycitric acid in lactone form with a series of steps. However, the Examiner feels that only the first half of the Lewis process by itself can produce the claimed metal salt. Furthermore, combining the first half of the Lewis process with the teachings of Lowenstein without acidification will certainly ensure the formation of the non-hygroscopic potassium salts of hydroxycitric acid. Moreover, the Examiner feels that even the combination of two prior arts does not lead an artisan to go through all the steps, but the artisan can modify the combined steps if necessary to produce the claimed compound. As such, it would have been

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obvious for the person having an ordinary skill in the art to have combined the references with modification in order to produce the desired product.

Conclusion

4. The examiner is requesting the applicants to file Affidavits or Declarations under Rule 132. Until all the issues are resolved, the rejections of all the claims are maintained. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist , can be reached on (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

T. Victor Oh



9/3/29



PAUL J. KILLOS
PRIMARY EXAMINER
1621